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Paper No. 9
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MicroStrategy Incorporated

Serial No. 75/647,888

Barbara A. Barakat of Hale and Dorr for MicroStrategy Incorporated.

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Quinn and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

MicroStrategy Incorporated has filed a trademark application to register the mark THE E-BUSINESS INTELLIGENCE PLATFORM for "computer education training services," in International Class 41, and "computer services, namely, providing computer consulting services, computer support services, namely, troubleshooting of computer hardware and software problems via telephone and

e-mail, computer software design for others," in International Class 42.¹

The Trademark Examining Attorney has finally refused registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that applicant's mark "refers to the computer hardware or software with processing capability underlying a computer system used for conducting business over the Internet." We take judicial notice of the following definitions, submitted late by the Examining Attorney, of "e-business" from *Prentice Hall's Illustrated Dictionary of Computing* (3rd ed. 1998), and of "intelligence" and "platform" from *The Computer Glossary* (7th ed. 1995), by Alan Friedman:

e-business - An enterprise that conducts many of its business functions through electronic means. ... The term also refers to businesses that operate on the Internet and offer goods, services, and information for sale via the Web. ...

¹ Serial No. 75/647,888, filed February 22, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

intelligence - Processing capability. Every computer is intelligent!

platform - The hardware architecture of a particular model or computer family. The term also often refers to just the operating system, which implies the particular hardware architecture that it runs on.

The Examining Attorney submitted excerpts of articles retrieved from the LEXIS/NEXIS database to "indicate that in the computer industry the wording BUSINESS INTELLIGENCE PLATFORM is commonly used to refer to the computer hardware or software underlying a particular type of computer system." The following are examples of these excerpts:

A snap-together business intelligence platform under construction by Cognos Inc. of Ottawa will create a Web portal for mixed enterprise data. [Government Computer News, September 27, 1999.]

New marketing applications will depend on good data. What's needed is the next generation of customer business intelligence platforms. [Direct, September 30, 1999.]

The latest version of the product [Intelligent Miner] will offer new ease-of-use features, such as visualization capabilities, that the IBM officials feel are essential in helping companies gain true business benefit from their business intelligence platform without having to rely on mathematicians to run their analytics. [InfoWorld Daily News, September 22, 1999.]

Schroeder says Brio's forthcoming Brio One business intelligence platform will address product integration concerns ... [ENT, September 8, 1999.]

According to Symons, about 3,000 customers chose the AS/400 as their business intelligence platform last year. [*MIDRANGE Systems*, April 13, 1998.]

Applicant contends that the Examining Attorney's "perception of the identified services is incorrect"; that applicant "is not providing platforms, intelligence platforms or business intelligence platforms"; that "applicant's are computer services, training, consulting, support services and software design for others"; and that applicant's trademark is, at most, suggestive because it "does not merely describe those services, their nature, characteristics or functions."

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

Having considered the evidence and arguments presented, we agree with the Examining Attorney's conclusion that "the mark THE E-BUSINESS INTELLIGENCE PLATFORM, in its entirety, is merely descriptive of a quality of the applicant's services in that the applicant provides consulting, technical support, design and education concerning ... computer hardware and software." It is reasonable to conclude that such computer hardware and software is likely to comprise or include a "business intelligence platform" or an "intelligence platform." Further, applicant's services, as identified, are not restricted to any particular sector of consumer and, thus, those consumers engaged in "e-business" are included within the scope of potential purchasers of applicant's services and described by applicant's mark.

Applicant, in its arguments as to why the mark is not merely descriptive, separates the fact that it

renders a variety of computer-related services from the subject matter of those services, *i.e.*, computer hardware and software, and one of the business sectors encompassed the market for applicant's services as identified, *i.e.*, "e-business."

Two arguments made by applicant warrant further discussion. First, applicant argues that its adoption of this phrase is unique, and that the Examining Attorney has failed to provide any evidence of third-party descriptive use of the phrase E-BUSINESS INTELLIGENCE PLATFORM. We note, however, that the fact that a term does not appear in a dictionary, or that it may not be in common usage in a particular industry, is not determinative. *See In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); and *In re Orleans Wines Ltd.*, 196 USPQ 516 (TTAB 1977).

Second, applicant argues that it owns another application for federal registration of the same mark for computer programs that was not refused by the Office on the ground of mere descriptiveness and was passed to publication. However, it is well settled that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the referenced application, and in any event, the Board

is not bound by decisions of Examining Attorneys in other *ex parte* cases. See *In re Nett Designs Inc.*, 236 F.3rd 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) and cases cited therein.

In the present case, it is our view that, when applied to applicant's services, the phrase THE E-BUSINESS INTELLIGENCE PLATFORM immediately describes, without conjecture or speculation, both the subject matter of the identified services and the intended purchasers or market for applicant's services. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective customers for applicant's services to readily perceive the merely descriptive significance of the phrase THE E-BUSINESS INTELLIGENCE PLATFORM as it pertains to applicant's services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.